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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/529,406

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Genevieve Rougon

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530

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07/05/2006

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EXAMINER

WANG, CHANG YU

ART UNIT

PAPER NUMBER

1649

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/529,406

Applicant(s)

ROUGON ET AL.

Examiner

Chang-Yu Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on December 12, 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

***Election/Restrictions***

1. Claims 8-16 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in alternative only and/or cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 8-16 have not been further treated on the merits.

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1 -5, drawn to a peptide comprising SEQ ID NO:1 and no more than 10 amino acids.

Group II, claim(s) 6 and 7, drawn to a method of identifying a compound able to revert the repulsory effect of sema3A on axonal outgrowth.

Group III, claim(s) 17, drawn to a method for attracting/modulating the direction of axonal growth by a cell.

Group IV, claim(s) 19-20, drawn to a method of screening molecules that prevent the internalization of L1 and NP-1.

Group V, claim(s) 21-23, drawn to the use of the Group I and as interpreted as method claims.

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3. The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The 1<sup>st</sup> claimed invention is drawn to a peptide comprising SEQ ID NO:1 and no more than 10 amino acids inducing axonal attraction in the presence of semaphorin. SEQ ID NO:1 is known in the art, the Invention of the Group I was found to have no special technical feature that defined the contribution over the prior art of WO200122920-

A2AAG76746. The sequence search results disclose as follows:

ID AAG76746 standard; protein; 43 AA.  
AC AAG76746;  
DT 03-SEP-2001 (first entry)  
DE Human colon cancer antigen protein SEQ ID NO:7510.  
KW Human; colon cancer; colon cancer antigen; diagnosis; detection; colorectal carcinoma.  
OS Homo sapiens.  
PN WO200122920-A2.  
PD 05-APR-2001.  
PF 28-SEP-2000; 2000WO-US026524.  
PR 29-SEP-1999; 99US-0157137P.  
03-NOV-1999; 99US-0163280P.  
PA (HUMA-) HUMAN GENOME SCI INC.  
PI Ruben SM, Barash SC, Birse CE, Rosen CA;  
DR WPI; 2001-235357/24.  
N-PSDB; AAH36151.  
PT Nucleic acids encoding 4277 human colon cancer-associated polypeptides, useful for preventing, diagnosing and/or treating colorectal cancers.  
PS Claim 11; Page 8929-8930; 9803pp; English.  
CC AAH32943 to AAH37195 and AAG73514 to AAG77788 represent human colon cancer-associated nucleic acid molecules (N) and proteins (P), where the proteins are collectively known as colon cancer antigens. The colon cancer antigens have cytostatic activity and can be used in gene therapy and vaccine production. N and P may be used in the prevention, diagnosis and treatment of diseases associated with inappropriate P expression. For example, N and P may be used to treat disorders associated with decreased expression by rectifying mutations or deletions in a patient's genome that affect the activity of P by expressing inactive proteins or to supplement the patients own production of P. Additionally, N may be used to produce the colon cancer-associated Ps, by inserting the nucleic acids into a host cell and culturing the cell to express the proteins. N and P can be used in the prevention, diagnosis and treatment of colorectal carcinomas and cancers. AAH37196 to AAH37204 and AAB77789 represent sequences used in the exemplification of the present invention. N.B.

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Pages 666 to 682 and page 7053 of the sequence listing were missing at time of publication, meaning no sequences are present for SEQ ID NO:1027 to 1052, 7921 and 7922

SQ Sequence 43 AA;

Query Match 100.0%; Score 5; DB 4; Length 43;  
 Best Local Similarity 100.0%; Pred. No. 53;  
 Matches 5; Conservative 0; Mismatches 0; Indels 0; Gaps 0;

Qy 1 ASNKL 5  
 |||||  
 Db 1 ASNKL 5

4. Since the 1<sup>st</sup> claimed invention has no special technical feature, it cannot share a special technical feature with the other claimed inventions. Thus, Applicant's inventions do not contribute a special technical feature when view over the prior art, they do not have a single inventive concept and so lack unity of invention.

Group I is drawn to a special technical feature of a peptide comprising SEQ ID NO:1 and no more than 10 amino acids, which lacks a corresponding special technical feature in common with the rest of Groups.

Group II is drawn to a special technical feature a method of identifying a compound able to revert the repulsory effect of sema3A on axonal outgrowth which lacks a corresponding special technical feature in common with the rest of Groups.

Group III is drawn to a special technical feature of a method for attracting/modulating the direction of axonal growth by a cell which lacks a corresponding special technical feature in common with the rest of Groups.

Group IV is drawn to a special technical feature of a method of screening molecules that prevent the internalization of L1 and NP-1 which lacks a corresponding special technical feature in common with the rest of Groups..

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Group V is drawn to a special technical feature of the use of the Group I which lacks a corresponding special technical feature in common with the rest of Groups. Group V is interpreted as method claims. However, if Applicant interprets claims 21-23 as composition claims, then they would be grouped together with Group I. Thus, Applicant's inventions do not have a single inventive concept and lack unity of invention.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). In order to be fully responsive, Applicant is required to elect a single group from designated groups I-V as set forth above to which the claims will be restricted, even though the requirement is traversed. The subject matter for examination will be restricted to the extent of the subject matter of the elected group

6. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

7. In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be

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fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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9. Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (571) 272-1600.
10. Papers relating to this application may be submitted to Technology Center 1600, Group 1649 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1600 is (571) 273-8300.
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chang-Yu Wang, Ph.D. whose telephone number is (571) 272-4521. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, Ph.D., can be reached at (571) 272-0867.
12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CYW  
June 22, 2006

  
**JANET L. ANDRES**  
**SUPERVISORY PATENT EXAMINER**